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10/779,767

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EXAMINER

CHU, KIM KWOK

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NOTIFICATION DATE

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|----------------------------------|--|
| Office Action Summary | Application No. 10/779,767 | Applicant(s) KO ET AL. | |
| | Examiner KIM CHU | Art Unit 2627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Remarks filed on June 2, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 18, 20 and 7016 is/are rejected.
- 7) ☒ Claim(s) 17 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/333,520.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Remarks

1. Applicant's Remarks filed on June 17, 2008 has been fully considered.

With respect to Claim 8 and 9, Applicant states that he establishes a priority date of invention on December 10, 1998 (page 8 of the Remarks, second paragraph, lines 8-10) which overcomes the 35 U.S.C. § 102 (e) rejection anticipated by Takhaisi (U.S. Patent 6,236,541). Accordingly, a newly found prior art of Braithwaite et al. (U.S. Patent 5,644,444) is cited to reject Claims 8 and 9. And in addition, Applicant is asked to resubmit the English translation of Korean Patent Application No. 98-54190 because the English translation is not found in Applicant's file.

With respect to the 35 U.S.C. § 102(e) rejection on Claims 1 and 13, Applicant states that the prior art of Ro et al. (U.S. Patent 6,288,989) does not teach a recording of a plurality of **identical** write prevention information (page 7 of the Remarks, line 12). Furthermore, Applicant uses Ro's Fig. 6 to support his assertion that the plurality of passwords are not identical (page 7 of the Remarks, lines 16 and 17). Accordingly, the prior art of Ro teaches a plurality of write prevention information (password) as illustrated in Fig. 6. Although each password is assigned to a program under different titles, all

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the passwords are identical because the passwords are used to identify a single user (Fig. 2b; steps 74 and 76; column 7, lines 37-40). In other words, a single user requires only a single password to protect a plurality of audio/video programs against unauthorized overwriting the programs.

Applicant further states that the prior art of Ro does not specifically require the overwrite protection information to be identical (page 7 of the Remarks, lines 18 and 19). Accordingly, a user's overwrite protection information (password) can be formed with a plurality of different passwords; however in the case of Ro's video/audio programs overwritten protection, there is no need to use a plurality of different passwords to performs this simple authorization operation. Under a single user, a single password is sufficient to protect all the video/audio programs against an error of overwritten (erasing) operation.

With respect to Claim 13, Applicant states that the prior art of Ro's plurality of overwrite prevention information is not recorded at the same time as required in Claim 13 (page 7 of the Remarks, last paragraph, lines 1 and 2). Applicant points out that Ro's passwords are recorded at separate times based on the recording of the corresponding audio/video program (page 7 of the Remarks, last paragraph, lines 5-7). Accordingly, Ro's

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passwords as illustrated in Fig. 6 are recorded at the same time during the recording of the programs. Although the passwords are not recorded simultaneously, they are recorded while audio/video programs are recorded. Since Applicant's Claim 13 does not specify the number of passwords are required to record in each program, Ro's plurality of passwords recorded together with the audio/video programs satisfies the requirement of Applicant's Claim 13.

With respect to the provisionally double patenting rejection on Claims 3, 7, 10-12, 14-16, 18 and 20 are remains to be allowable if a Terminal Disclaimer is submitted.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 19 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 19 of the '713 patent contains all of the features of the above mentioned claim 1.

4. Claims 2-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not

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patentably distinct from each other because claims 1 and 9 of the '713 patent contains all of the features of the above mentioned claims 2-4. For example:

(a) as in claim 4, the recording medium is a bare disc not contained in a case or cartridge (DVD-R is a bare disc).

5. Claims 5 and 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32, 36 and 40 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 32, 36 and 40 of the '713 patent contains all of the features of the above mentioned claims 5-7.

6. Claims 8-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14 and 15 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 14 and 15 of the '713 patent contains all of the features of the above mentioned claims 8-11.

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7. Claim 12 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the '713 patent contains all of the features of the above mentioned claim 12. For example:

(a) with respect to the present Claim 12, the claimed feature "write protection information being redundantly stored" is the stored passwords as claimed in Claim 1 of the '713 patent; and

(b) the DVD-R and/or DVD-RW limitation in the present Claim 12 is the DVD specification as claimed in Claim 1 of the '713 patent.

8. Claims 13-16, 18 and 20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of U.S. Patent 6,744,713. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1 and 9 of the '713 patent contains all of the features of the above mentioned claims 13-16, 18 and 20. For example:

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(a) as in claim 13, the limitation "recording management data area" is the "Lead-in area" cited in Claim 1 of the '713 patent.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

10. Claims 1 and 13 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ro et al. (U.S. Patent 6,288,989).

11. Ro teaches a write protection method for an optical disc recording and/or reproducing apparatus having all the steps as cited in claim 1. For example, Ro teaches the following:

(a) with respect to Claim 1, checking write protection information stored in an RMD (Recording Management Data) field of a RMA (Recording management Area/Lead-in) area to protect data recorded on the recording medium from unwanted overwriting or erasing (Fig. 6; password protection) and prohibiting writing of data on the recording medium according to the write protection information (Figs. 3-5), wherein the write

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protection information is redundantly stored in physically separate locations (Fig. 6; multiple passwords are stored in the Lead-in medium management area).

12. Apparatus claim 13 is drawn to the apparatus corresponding to the method of using same as claimed in claim 1. Therefore apparatus claim 13 corresponds to method claim 1, and is rejected for the same reasons of anticipation as used above. Claim 13 however also recites the following limitation which is also taught by the prior art of Ro:

(a) with respect to Claim 13, a user area (Fig. 6; data area is the user area).

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13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

14. Claims 8 and 9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Braithwaite et al. (U.S. Patent 5,644,444).

Braithwaite teaches a storage device having all the elements and means as cited in claims 8 and 9. For example, Braithwaite teaches the following:

(a) with respect to Claim 8, the storage device comprising: a recordable and/or rewritable recording medium 60 (Fig. 4) including a Lead-in area 64 (Fig. 4; column 4, lines 56-66; a Lead-out area 66 (Fig. 4); and a user data area 62 (Fig. 4); and a cartridge 24 (Fig. 2) having a case which receives the recording medium 60 (Fig. 4); wherein the recording medium 60 is set to a write protection state (column 5, lines 29-32), ensuring the protection of data, including the entire user data area 62 or at least a plurality of particular data files 68 (Fig. 4), recorded on the recording medium 60 from unwanted overwriting or erasing, when the finalization (recording is done and the medium can be ejected) for writing on

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the Lead-in area and the Lead-out area has been completed (Fig. 4; column 5, lines 29-37; column 6, lines 12-19).

(b) with respect to Claim 9, the case has a recognition switch 18 for write protection (Fig. 3; shutter is for write protection when it is not opened).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. Claims 2, 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ro et al. (U.S. Patent 6,288,989) and further in view of Yonemitsu et al. (U.S. Patent 5,793,779).

17. Ro teaches a recordable and/or rewritable recording medium to record data very similar to that of the instant invention as in Claims 2 and 4. For example, Ro teaches the following:

(a) as in claim 2, the medium has an entire user data area or at least a plurality of particular data files (Fig. 6); a Lead-in area (Fig. 6); wherein upon the finalization (updating)

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for writing on the Lead-in area has been completed, the recording medium is set to a write protection state ensuring the protection of the data recorded on the recording medium from unwanted overwriting or erasing (Figs. 2A and 4; each program can be set to a protected mode or non-protected mode.

However, Ro does not teach that the recording medium has a Lead-out area during a finalization stage.

Yonemitsu et al. teaches a recording medium having a Lead-out area (Fig. 5).

Although Ro does not teach a Lead-out area in his recording medium, the Lead-out area is not a novel medium specification. For example, Yonemitsu teaches an optical recording medium having a Lead-out area as an information reserve region. Hence, when there is a motivation of storing file management data, it would have been obvious to one of ordinary skill in the art at the time of invention to divide an optical recording medium into a Lead-in area, a Lead-out area and a user data such as Applicant's and Yonemitsus's, because the Lead-out area can be used as an additional region for updating/finalizing management information other than user data.

(b) as in Claim 4, the recording medium 10 is a bare disc not contained in a case of a cartridge (Fig. 1).

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18. Apparatus claim 5 is drawn to the apparatus corresponding to the method of using same as claimed in claim 2. Therefore apparatus claim 5 corresponds to method claim 2, and is rejected for the same reasons of anticipation as used above. Claim 5 however also recites the following limitation which is also taught by the prior art of Ro:

(a) with respect to Claim 5, a user area (Fig. 6; data area is the user area).

Allowable Subject Matter

19. Claims 17 and 19 are objected to as being dependent upon rejected claims based on obvious double patenting, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 17, the prior art of record considered as a whole fails to teach or fairly suggest a recording medium having a recording information area, distinct from the Lead-in area, the Lead-out area and the user data area, and including RMD fields, wherein the RMD fields store information indicative of pre-use certification and defect management in use.

Regarding claim 19, the prior art of record considered as a whole fails to teach or fairly suggest a recording medium having write protection information which is stored in a byte

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position BP3 of RMD field 0, and information indicative of types of recording medium, indicating whether the recording medium satisfies the DVD-RW specification, is stored in byte positions BP0 and BP1 of the RMD field 0.

The features indicated above, in combination with the other elements of the claims, are not anticipated by, nor made obvious over, the prior art of record.

20. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached on (571) 272-7579.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9191 (toll free).

/Kim-Kwok CHU/

Examiner AU2627
June 27, 2008
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Supervisory Patent Examiner, Art Unit 2627